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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91213597
Party	Defendant Tigercat International Inc.
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Date	04/07/2015
Attachments	MOTION AND MEMORANDUM FOR SANCTIONS AND SUSPENSION OF PROCEEDINGS (M1356324).pdf(510106 bytes)

BY

DATE: _____

On August 25, 2014, Tigercat filed a Motion to Compel Discovery Responses. On February 4, 2015, the Board issued an order granting, in part, Applicant's Motion and compelling Opposer to provide responses to Applicant's Interrogatories Nos. 1, 3, 8, 9, 11, 12, 16, and 18 and Applicant's Request For Production Nos. 14, 19, 20, 21, 24, 26, 27, 28 and 29. Applicant was given until March 6, 2015 to provide substantive responses to the above identified Interrogatories and Requests for Production.

Opposer's supplemental responses of March 6, 2015 and April 3, 2015 still do not comply with the Board's Order with respect to Tigercat's Interrogatories Nos. 9, 11, 12 and 19, and Applicant's Requests For Production Nos. 24, 26, 27, and 28.

**THE BOARD HAS AUTHORITY TO ENTER SANCTIONS FOR FAILURE TO
COMPLY WITH AN ORDER TO COMPEL**

Fed. R. Civ. P. 37, as made applicable to Board proceedings in 37 C.F.R. §§2.116 and 2.120(g), grants the Board authority to enter sanctions for failure to comply with orders relating to discovery.

Tigercat's efforts to secure adequate responses to the above-identified discovery requests have been unavailing.

In response to the Board's February 4, 2015 Order, on March 6, 2015, Opposer offered Supplemental Responses and Production to Applicant's First Set of Interrogatories and Applicant's First Set of Request For Production. Much of its supplemental production was insufficient.

On March 18, 2015, Tigercat wrote¹ to Opposer detailing the insufficiencies in Opposer's supplemental production, specifically in regards to its responses to Interrogatories Nos. 8 and 12 and Requests for Production Nos. 14, 19, 20, 24, 26, 27 and 28. On March 23, 2015, Opposer responded² to Tigercat's March 18 letter. The response continued Opposer's refusal to provide sufficient appropriate responses to the discovery requests which were the subject of the Board's Order and Tigercat's March 18 letter. On March 27, 2015, Tigercat in an effort to resolve the

¹ A copy of that letter is attached as Exhibit A to Declaration of Candace Lynn Bell (hereafter "Bell Decl.").

² A copy of that letter is attached as Exhibit B to Bell Decl.

matter without recourse to a sanctions motion, wrote³ to Opposer detailing the deficiencies in Opposer's responses. On April 1, 2015, Opposer responded⁴ to Tigercat's March 27 letter. Opposer's response continued Opposer's refusal to provide sufficient responses to the discovery requests which were the subject of the Board's Order and Tigercat's March 18 and March 27 letters. On April 2, 2015, Tigercat wrote to Opposer reiterating the deficiencies in Opposer's responses⁵. Later on April 2, 2015, Opposer responded⁶ to Tigercat's April 2, 2015 letter. Opposer's response continued its delay in fully complying with the Board's Order and continued Opposer's refusal to provide sufficient responses to the discovery requests which were the subject of the Board's Order and Tigercat's March 18, March 27 and April 2 letters. On April 3, 2015, Caterpillar served additional supplemental responses to Tigercat's interrogatories and requests for production which again did not address all of the deficiencies in its responses.

Opposer has not complied with the Board's February 4 Order with respect to Tigercat's Interrogatories Nos. 9, 11, 12 and 19, and Applicant's Request For Production Nos. 24, 26, 27, and 28.

Opposer Has Failed to Comply with the Board's Order

With respect to Interrogatory No. 12, which relates to third party uses, of which Opposer is aware, of "CAT" as a mark or name or component of a mark or name in connection with any goods or services identified in Opposer's Registrations, Opposer improperly attempts to limit its supplemental responses by implausibly defining the term "use" to mean filing of a trademark application or the maturing to registration of applications. Opposer produced a trademark search

³ A copy of that letter is attached as Exhibit C to Bell Decl.

⁴ A copy of that letter is attached as Exhibit D to Bell Decl.

⁵ A copy of that letter is attached as Exhibit E to Bell Decl.

⁶ A copy of that letter is attached as Exhibit F to Bell Decl.

report on March 6, 2015 and referenced such report as being responsive to Interrogatory No. 12. In Opposer's second supplemental production of April 3, 2015, three additional trademark search reports from March 2012 for registrations for marks including the word "CAT" in all goods and service classes, not just the goods and services of Opposer's relied upon registrations, were produced. As Opposer well knows, the existence of a trademark application or registration does not establish that the mark is in use. The search reports do not respond to the question: what marks having "CAT" as a component Opposer knows to be in use for goods and/or services set forth in Opposer's relied upon registrations. Neither the supplemental responses nor the supplemental document production are responsive to Interrogatory No. 12.

Opposer admits in its Second Supplemental Response to Interrogatory No. 12 that it has provided only an incomplete listing of relevant third party users of marks and names which contain the term "CAT". Opposer states:

Regarding common law references not identified in the above references [trademark searches], Caterpillar routinely objects to the third parties that become known to it who make use of Opposer's Marks or similar marks and names. Over the last five years, some of these parties that have become known to Caterpillar have included(Opposer's Second Supplemental Response to Interrogatory No. 12).⁷

Opposer's production, however inadequate, establishes that it has failed to provide the information it was ordered to produce because it has provided a response including only some of the third party uses of marks and names which contain the term "CAT" which are known to it.

⁷ A copy of that response is attached as Exhibit G to Bell Decl.

With respect to Requests for Production Nos. 24, 26, 27 and 28, and the corresponding Interrogatory Nos. 9 and 11, which relate to market research and consumer studies done by or on behalf of Opposer or any third party related to Opposer's Marks, documents referring or relating to purchaser recognition of Opposer's Marks, market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer's Marks, and documents referring or relating to consumer recognition of Opposer's Marks, Opposer has identified and produced only two scripts for a limited category of surveys, namely purchaser satisfaction surveys of purchasers of Opposer's goods, none of which are responsive to the order directing supplemental responses and production in response to Tigercat's requests for market research directed to recognition of the asserted marks and the alleged fame of the asserted marks. The scripts, one for a product use survey and one for an initial purchase survey, (CAT 11023 – 11030 and CAT 11031 -11045) are not market research surveys directed to Opposer's Marks, nor purchaser or consumer recognition of Opposer's Marks nor alleged fame of Opposer's Marks, as requested in Request Nos. 24, 26, 27 and 28 and as ordered by the Board. In its April 3, 2015 supplemental production, Opposer provided five (5) additional documents relating to product use and initial purchase surveys for Caterpillar's customer loyalty program. (CAT 12985 – 12999, CAT 21081 – 21106, CAT 21107 – 21134, CAT 21135 – 21165, and CAT 21166 - 21174). These documents likewise are not responsive. They are neither market research surveys directed to Opposer's Marks, nor surveys directed to purchaser or consumer recognition of Opposer's Marks nor surveys directed to the alleged fame of Opposer's Marks, as requested in Interrogatory Nos. 9 and 11 and Request Nos. 24, 26, 27 and 28 and as ordered by the Board.

Caterpillar has not provided Bates number ranges as to which documents are responsive to which specific requests for production, although Opposer has pointed Tigercat to certain documents in Opposer's letters continuing its refusal to produce responsive documents and in its Supplemental Responses to Interrogatories Nos. 9 and 11. Caterpillar's State of the Brand reports (CAT 10931-10964, CAT 10965-11022, CAT 11074-11088 and CAT 11166 - 11242) claimed by Opposer to be responsive to Interrogatories Nos. 9 and 11 and Requests Nos. 24, 26, 27 and 28 are not responsive to those requests. They are not market research or consumer studies. Third party stories about "valuable brands" (CAT 05261 – 05290, CAT 06720 – 06730, and CAT 11090) produced and claimed by Opposer to be responsive to Interrogatories Nos. 9 and 11 and Requests Nos. 24, 26, 27 and 28 are not responsive to those requests. They are not surveys or market research directed to public or consumer awareness or recognition or fame.

Caterpillar's response does not comply with the Board's Order, although Opposer has in other proceedings, and when it suited its interests, produced such market research and consumer surveys. By way of example only, Opposer produced market research and consumer studies in the European Union Community Trademark Application Opposition between the parties. (See Exhibits 41, 43 and 45A from the Opposition filed before OHIM by Caterpillar against Tigercat, Opposition No. B2285602). Such documents were requested by Tigercat in Interrogatories Nos. 9 and 11 and Requests Nos. 24, 26, 27 and 28 and the Board ordered that these be produced. If Opposer has done no such studies in the United States, Opposer must so state.

In its April 1, 2015 letter, Opposer stated: "...no similar study (or any study at all) has been requisitioned or performed for this proceeding." This response demonstrates Opposer's bad faith disregard both of its discovery obligations and the Board's Order. Tigercat's requests for

production and the Board's Order were not limited to studies done expressly for this proceeding, but rather studies done related to Opposer's marks.

In its April 3, 2015 Second Supplemental Responses to Interrogatory No. 11, Opposer stated: "Relying upon this widespread marketplace acknowledgement of its consumer recognition and fame, Opposer has not separately conducted any surveys regarding the fame of the Opposer's Marks in the last five years."⁸ Tigercat's Interrogatory Nos. 9 and 11, Requests for Production Nos. 24, 26, 27 and 28 and the Board's Order were not limited to surveys nor limited to surveys regarding fame of Opposer's Marks, but rather all documents referring or relating to purchaser recognition of Opposer's Marks, market research and consumer studies done by or for Opposer or by any third party related to the fame or recognition or awareness of Opposer's Marks, and documents referring or relating to consumer recognition of Opposer's Marks. Opposer has not complied with the Board's Order as to the specific interrogatories and requests except insofar as it conceded it has no consumer or market research within the last five years that is directed to or otherwise establishes the alleged fame of Opposer's asserted marks.

**Tigercat Is Entitled to Entry of Effective Sanctions
for Opposer's Violations of the Board's Discovery Order.**

Opposer has willfully failed to comply with the Board's Order compelling discovery.

The sanctions appropriate for Opposer's failure to comply with the Order compelling discovery include: (i) directing that the matters embraced in the Order or other designated facts be taken as established for purposes of the action, as the prevailing party claims and (ii)

⁸ A copy of that response is attached as Exhibit G to Bell Decl.

prohibiting the disobedient party from supporting or opposing designated claims or defenses, or from introducing designated matters in evidence. Fed. R. Civ. P. 37.

In *Highbeam Mktg., LLC v. Highbeam Research, LLC*, the Board granted applicant's motion for entry of discovery sanctions based on the opposer's failure to comply with the Board's order compelling discovery, holding that the opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it. 85 U.S.P.Q.2d 1902 (TTAB 2008). Tigercat requests the Board similarly grant Tigercat's motion for sanctions based on Opposer's failure to comply with the Board's Order compelling discover and order that Opposer may not rely at trial on discovery materials disclosed only after entry of sanctions against it. *Id* at 1905; TBMP §527.01(a).

Tigercat asks that Opposer be precluded from denying that there are third party users of the term “Cat” for the goods and services identified in Opposer’s relied upon registrations (Interrogatory No. 12).

Tigercat asks that Opposer be precluded from relying on any market research or consumer studies done by or on behalf of Opposer or any third party related to Opposer’s Marks, and from relying on any market research or consumer studies done by or on behalf of Opposer or any third party to evidence purchaser recognition of Opposer’s Marks for Opposer’s Goods and Services, and the fame or recognition or awareness of Opposer’s Marks for Opposer’s Goods and Services as identified in Opposer’s relied upon registrations ((Interrogatory Nos. 9 and 11 and Requests For Production Nos. 24, 26, 27, and 28.)

Tigercat asks the Board for an adverse inference against Opposer in regards to its failure to produce market research and consumer studies, namely the inference that Opposer has no

market research conducted prior to the filing of the application for registration herein opposed that establishes:

(1) that the asserted marks of Opposer are famous among the general public in the United States; and

(2) that the term “CAT” as used by Opposer is associated with anything other than “CATERPILLAR” in the relevant markets.

**Tigercat Requests a Stay in this Proceeding
while the Board Considers this Motion for Sanctions**

Tigercat requests the Board suspend this proceeding pending its decision on this Motion for Sanctions. 37 CFR §2.117(c) Tigercat has asked for an adverse inference that Opposer has no market research conducted prior to the filing of the application for registration herein opposed that establishes: (1) that the asserted marks of Opposer are famous among the general public in the United States; and (2) that the term “CAT” as used by Opposer is associated with anything other than “CATERPILLAR” in the relevant markets. While not dispositive of this proceeding, if the Board grants this motion and orders such inference, Opposer will not be able to prove one prong of the test for dilution, the second ground for Opposition, which is significant and affects the upcoming discovery in this case.

Expert disclosures are due April 13, 2015 and discovery closes May 13, 2015. Because of the discovery requests at issue in this motion and the sanctions sought by Tigercat, the Board’s ruling will affect the scope of expert opinions as well as the depositions of Opposer’s witnesses. Tigercat respectfully submits these reasons show sufficient good cause for suspension and requests the case be suspended pending disposition of this motion.

Conclusion

Opposer's willful failure to comply with the Board's Order compelling discovery warrants sanctions against Opposer as set forth above. Tigercat requests the Board grant this Motion for sanctions and stay this proceeding until the Board issues its decision on this Motion.

Respectfully submitted,

Date: April 7, 2015



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CERTIFICATE OF SERVICE

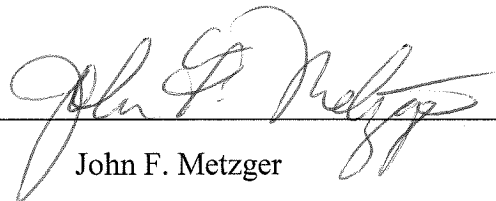
The undersigned hereby certifies that a true and correct copy of the attached APPLICANT'S MOTION AND MEMORANDUM OF LAW FOR SANCTIONS was served on counsel for the Opposer on the date listed below via electronic mail, as agreed to service between the parties, with a courtesy copy sent by U.S. Mail:

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Dated: April 7, 2015

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